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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,191	11/13/2001	Christoph Dobrusskin	PHN 16,257A	4074
24737 7590 11/27/2009 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			EXAMINER HYLINSKI, STEVEN J	
			ART UNIT	PAPER NUMBER
			3714	
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			11/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/014,191

Applicant(s)

DOBRUSSKIN ET AL.

Examiner

STEVEN J. HYLINSKI

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6, 12 and 16-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6, 12, 16-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 07/27/2009 have been fully considered but they are not persuasive. The new limitation of an interaction point is not enabled by the specification and is not claimed in a way that precludes Examiner from interpreting the software items of Harris in view of Baker, such as the "Control Appliance" blocks **102** and **116** of Fig. 10, as interaction points, because at these decision blocks (points), the system grants the user having an electronic device, the ability to control (interact) at different program levels, with a designated appliance.
2. In an attempt to refute Examiner's finding of the visual appearance of the icons being, in addition to being rendered obvious by the prior art disclosures of Harris in view of Baker, a matter of aesthetic design change or change in size/shape, Applicant relies on a line of the specification that states that the styling of the items makes it easier for children and others to identify them. Icons, by definition in the art, are used in order for the end user to identify them. This is not an unexpected result that can be used to successfully refute Examiner's finding of obviousness. In the case of Harris in view of Baker, the video reel icons are associated with the command they afford the user of the VCR machine, which is consistent with Applicant's specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4-6, 12, and 16-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim does not distinguish whether "an interaction point" is a separate and distinct limitation from an icon, so Examiner has consulted the brief, 4 page-long, specification to seek clarification. Examiner can not find support for an interaction point in the specification and therefore finds this new limitation to be impermissible New Matter. Because there is no definition for an interaction point in the claims or specification, Examiner is interpreting the icons of Harris in view of Baker, as being interaction points.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 4-6, 12, and 16-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,331,972 to Harris et al. (Harris), in view of US 5715416 to Baker.**

Re Claims 4, 12, 16, 23, 25-26, 28, and 30,

Harris discloses a multimedia method and computer program for use with a screen-based host system (Col. 6 Lines 11-54, Harris discloses a peer-to-peer

system, which by definition means that each node, which can be a PDA, cell phone, PC, etc, and hence-screen based, functions as both a client and server or host at the same time, without the need for a central server.) **provided with information processing and I/O facilities** (Fig. 2 shows exemplary hardware included in a peer device, which includes processor **40** and optional I/O devices **46**), **and for interacting with an item, the method comprising: receiving identity information from the item at the host** (Fig. 6, block **82** shows that the two peer to peer devices evaluate their needs vs. capabilities. Figs. 8 and 9 give examples of needs and capabilities that each device can have, which include information that identify the device.) **in response to proximity conditions between the host and the item** (Col. 6 Lines 31-35), **presenting to a user an icon that is representative of the item** (Harris states in Col. 19 Lines 49-58 that the icon of Fig. 20 is "a suitable icon **311**" that is accompanied by command text for a particular command. As discussed in the argument section above, the icons **311** that are functionally tied to the VCR of Fig. 20, would obviously be recognizable by one of skill in the art, as representing video reels. Video reels can reasonably be interpreted as representing a video cassette recorder machine due to their common theme. Even if, for the sake of argument, the icons **311** were not recognizable as video reels that could be associated with the VCR device, which Examiner is not conceding, MPEP § 2144.04 states that aesthetic and change-in-shape differences over the prior art fail to render an invention patentable. Furthermore, the visual appearance of a graphical user interface icon can be rejected as a design choice consideration, as discussed above) **and associated service field at the host in response to the identity information** (Col. 12

Lines 62-67 and Col. 13 Lines 1-5, if the two devices are in range of each other and their capabilities and needs are compatible, a program is transferred from one device to the other and a user interface is automatically loaded to allow the user of one device to access the other device. Fig. 20 shows an example of a user's device **300** that has had a program loaded on it to control another device. The graphical user interface shown on display **309** is clearly a service field.), **and transmitting information based on the interaction from the host to the item including the interaction point** (As discussed above in the arguments, Examiner is interpreting the decision blocks such as **102** and **116** in Fig. 10 as being points at which the user's electronic device (item) is granted the ability to interact with the other device (host)) **for storage at the item** (Figs. 8-9 show examples of data items that one device needs to transfer from the other device when the control appliance point **102** has been reached. Each device has memory **42** as shown in Fig. 2, which must at least temporarily store data received from the other device), **selecting an icon that is representative of the item** (Fig. 20, arrow **312** indicates the user's selection of one of the icons **311**. See the rejection of claim 4 above, in which it is discussed that the icons can be interpreted as video reels that one of skill in the art would associate with the VCR device, and alternatively, that changes in shape and aesthetic changes do not render an invention patentable over the prior art per MPEP 2144.04) **and application program based on the identity information, the application program including one of an information processing program and an entertainment program** (Col. 12 Lines 62-67 and Col. 13 Lines 1-5, if the two devices are in range of each other and their capabilities and needs are compatible, a program is

transferred from one device to the other and a user interface is automatically loaded to allow the user of one device to access the other device, hence the program is an information processing program), executing the application program at the host system (Fig. 10 **112**)

However, Harris lacks the icons varying location within a service field of the application based on actions of a user to facilitate interaction with the application program, the icons being user-definable, and being animated.

Baker is an analogous prior art reference in the art of graphical user interfaces , that proves it is very old and well-known in the art to allow users of a graphical user interface to create their own user-definable icons for use in the graphical user interface, (See Columns 3 and 9) and also that icons can be animated with animations unique to the icon (Column 9 Lines 38-67). Animating icons according to the method of Baker, also meets the limitation of **the icon varying location based on the actions of the user, to facilitate the user's interaction with the service field including an interaction point related to the service field and the user interaction** (Col. 9 Lines 34-65 describes how icons have icon-specific animations. As discussed above in the arguments, Examiner is interpreting that at the time the user's electronic device is allowed to connect to another device (**102**) and take control of the device (**116**), interaction points are reached. Interaction point **116** provides the service field. Baker further provides evidence that the shape of the icon, such as that used by Harris as discussed above, is a design choice consideration in the art. Baker states that it is known for each icon in an operating system, to be associated with a structure that

contains information that associates operating system file objects with the icon, and also pictorial information with the icon. Col. 22 shows that it is known for the data structure describing the icon, to contain information labeled "**icon.image", which specifies what image is associated with the icon.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art, that incorporating Baker's old and well-known teaching of user definable and animated icons being used to improve a graphical user interface having icons associated with commands, into Harris' compatible and ready-for-improvement invention, would cause results predictable to one of skill in the art, devoid of any new or unexpected consequences.

Re Claim 5,

Harris discloses enabling the user to activate information processing operations at the host related to the associated service field and the interaction point (Col. 13 Lines 1-8, the user at one peer device can control the other peer device using the user interface that has been loaded, this control being granted when a decision block such as 116 is reached in Fig 10.).

Re Claim 6,

Harris discloses transmitting host-generated results related to the associated service field during such proximity conditions to the item (Fig. 20 shows the exemplary embodiment of host 300 being able to send commands to one or more VCR's. These commands, input by the user using the interface on the PDA, constitute host-generated results.)

Re Claims 22, 24 and 29,

Examiner discusses above how one of skill in the art would recognize the icons **311** associated with VCR commands, as video reels intended to establish their functional relationship to the VCR device. Even if this fact is argued, MPEP 2144.04 states that aesthetic design changes and changes in shape fail to render an invention patentable over the prior art. Changing the visual identity of an icon constitutes both an aesthetic design change and a change in shape. Furthermore, in view of Baker's teaching that it is old and well-known in the art that the images associated with icons in graphical user interfaces can be readily changed, it would have been further obvious to one of ordinary skill in the art, at the time the invention was made, that changing the visual identity of an icon in a graphical user interface already including 2D icons, would produce merely predictable results.

Re Claims 17 and 31,

In Col. 12 Lines 62-67 and Col. 13 Lines 1-5, Harris discloses that one of the peer devices loads an application program from the other, and then presents the user's device with a user interface based on the program. Harris shows providing an iconized representation of an item at a host in response to the identity information in Fig. 20. In this figure, PDA **300**, which is both a host and a client since it is used in a P2P network, provides iconized representations of a VCR with host-commandable features of the VCR represented by icons **311**. In order to provide icons of the VCR to the host, the PDA, the PDA must know what the identity of the VCR is, since Harris' system can be used with many different types of devices. Col. 6 Lines 27-37 discloses, and Fig. 6

shows the P2P devices exchanging information regarding their needs and capabilities “for forming a communication network”. Fig. 21 shows addresses being exchanged between two items. Harris discloses in Col. 18 Lines 40-67 that “Controller **300** includes [...] display **309** showing icons **311** corresponding to available commands. Cursor **312** indicates which of icons **311** is selected, with display **307** providing a textual description or identification.” Although icons **311** represent VCR tapes that can have actions performed on them from the PDA host, it is understood that the icons could be representations of the features of any of the other devices that Harris shows in Fig. 3 can be used in his invention.

Re Claims 18-19,

Harris discloses that the peer devices compare the needs of one device with the capabilities of the other (Fig. 6, blocks **82** and **84**). Figs 8-9 show that the needs of one device can be audio and/or video capability from the other device. Regarding enabling a user to resume a discontinued interaction, Harris shows in Fig. 10 how a service connection is processed, including having to acquire and download data specific to a remote device, before the user can control it from the user interface. Col. 20 Lines 48-65 states that the user interface has memory for database capabilities including storage and retrieval of data. Being able to recall locally stored data instead of having to re-acquire the personalization data **104** (Fig. 10) every time a user connects with a device, would cause predictable results using the already-capable system of Harris in view of Baker, the result being allowing a user to resume a session without having to redundantly download the same data each time.

Re Claim 20,

Figs. 8-9 show that one device can need personal information, such as the owner's name, security settings, or a financial transaction, from the other device.

Re Claims 21 and 27,

Harris discloses the information that is transmitted to the item including a state of the application program identified by the interaction point (Blocks 110 and 112 of Fig. 10 disclose uploading the application program to one of the peer devices, and then executing it once it has uploaded. In order for Harris' system to progress from block 110 to 112, the peer receiving the program must know that the program has completely uploaded, which constitutes transmitting a state of the program, else the Control Appliance process 102 would not function.).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. HYLINSKI whose telephone number is (571)270-1995. The examiner can normally be reached on Mon-Fri 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling, III. can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

/STEVEN J HYLINSKI/
Examiner, Art Unit 3714